II. REMARKS

Claims 68 to 103 are pending in the subject application. Claims 68 to 85 and 95 to 103 are withdrawn from consideration pursuant to 37 C.F.R. § 1.142(b) as being drawn to a non-elected group or species. Amended claims 86 to 94 are currently under consideration.

Independent claim 86 has been amended to further define that the polymer is a "physiologically compatible polymer comprised of at least one synthetic polymer" to distinguish it from naturally occurring cornea tissue removed from animals and transplanted into the eye. The polymers of the subject invention contain at least one non-naturally occurring polymer, and which may include synthetic counterparts to naturally occurring polymers. Support for this amendment is found on page 4, lines 1 to 7. An issue of new matter is not raised by this amendment and entry thereof is respectfully requested. The dependent claims have been amended to correct dependencies resulting from the renumbering of the claims.

The specification has been amended to correct grammatical and typographical errors. An issue of new matter is not raised by the amendments to the specification. The Abstract has been amended as suggested by the Office. An issue of new matter is not raised by the amendments to the Abstract.

In view of the preceding amendments and the remarks that follow, reconsideration and withdrawal of the rejections of the claims is respectfully requested.

Objections to the Specification

The Office objected to the disclosure on page 19, line 23, "my" was requested to be replaced by --may—and the word "are" was requested to be deleted from page 25, line 16. The Office also noted that on page 36, line 16, the word "Preferably" is misspelled. The Office required correction.

In accordance with the Office's suggestion, the specification has been reviewed for typographical and grammatical errors. Correction of errors have been noted, above,

Accordingly, removal and reconsideration of the objections to the specification is respectfully requested.

Objection To The Abstract

The abstract of the disclosure was objected to because it is not "limited to a single paragraph within the range of 50 to 150 words". The Abstract has been amended herein to limit it to a single paragraph having a word range of 50 to 150 words. In view of this amendment, reconsideration and withdrawal of the objection is respectfully requested.

35 U.S.C. § 102 (b)/§ 103

Claims 86-93 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Herrick, U.S. Patent No. 4,781,187, which employs donor corneal tissue (inherently comprising natural polymers such as collagen and mucopolysaccharide) as the implant material (column 3, lines 41-49). The Office argued that substituting a synthetic polymer material would have been obvious in order to provide greater control over material properties, to reduce risk of disease transmission, to ensure availability of materials, and so on, especially in the absence of any advantage or criticality in the instant disclosure of synthetic polymers over natural polymers. The Office noted that the Applicant's specification states that synthetic or natural polymers may be used (page 1, lines 18-19; page 17, lines 15-17) and even includes collagen as a possible material (original claim 63). The Office also argued that synthetic polymers were well known in the art, as evidenced by the Applicant's statements at page 2, line 24 *et seq.* of the specification and by prior art references of record. With respect to claims 88 and 89, the Office opined that a radius of curvature within the prescribed ranges would have been immediately obvious from the intended use of the device, as best illustrated by Figures 3, 4, 7, and 9. With respect to claims 91-93, the Office stated that although Herrick specifies typical dimensions "on the order of a length of 3.5 to 4.0 millimeters" (column 3, lines 52-56), lengths as low as 2.0 millimeters would

have been obvious in order to accommodate experimentation or practice on rabbits and other small animals or to minimize the length of the corneal incision.

Applicants respectfully traverse. Although synthetic polymers were known in the art, at the time the application was filed, it was not an obvious variation to substitute a polymer for a natural material. For this reason, the rejection is improper and therefore should be withdrawn.

Claims 86-93 also stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Gonchar et al., "Interlayer Refraction Tunnel Keratoplasty in Correcting Myopia and Astigmatism". The Office argued that implants being of a synthetic polymer would have been an obvious material variant for reasons provided above with respect to the Herrick patent. Regarding claims 88 and 89, the Office stated that values within the specified ranges would have been immediately obvious from the purpose of the implants (Figure 3). Regarding claim 93, the Office argued that an implant having a length of 2.0 mm or less would have been obvious in order to accommodate a variety of eye sizes (e.g., page 2, lines 3-4, of said translation) and refractive disorders.

Applicants respectfully traverse. Although synthetic polymers were known in the art, at the time the application was filed, it was not an obvious variation to substitute a polymer for a natural material. For this reason, the rejection is improper and therefore should be withdrawn.

Claims 86, 87, and 90 also stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Civerchia, US Pat. No. 5,213,720. The Office stated that regarding the last two lines of claim 86, MPEP 2106, section II. C., explains that language which suggests or makes optional but "does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation"; "examples of language that may raise a question as to the limiting effect of the language in a claim" are "adapted to" and "adapted for" clauses. The Office stated that the embodiments shown in Figures 14 and 17 can be inserted into the cornea (Figure 4; column 6, lines 20-21; column 18, lines 9-12) and thus possess a radius of curvature along a centroidal axis of at least 5.0 mm; because of their elongate form, these embodiments clearly extend in a meridional direction.

Claims 88, 89, and 91-93 are further rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Civerchia, US Pat. No. 5,213,720. Regarding claims 88 and 89, the Office argued that the particular radius of curvature would have been immediately obvious from the anatomy depicted in Figure 4. With respect to claims 91-93, the Office argued that the length of the tabs **132** being less than or equal to 2.0 mm would have been obvious from the drawing (Figure 17) and would have been obvious in order to lessen the trauma to the cornea.

Applicants respectfully traverse for the reasons of record. Civerchia discloses a contact lens that sits on top of the cornea. In contrast, Applicants claim an insert, not a lens as disclosed in the cited art. Reconsideration and withdrawal of the rejection is respectfully requested.

III. CONCLUSION

If a telephone interview would advance prosecution of the subject application, the Examiner is invited to telephone the undersigned at the number provided below. In the unlikely event that the transmittal letter is separated from this document and/or the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account**

No. 50-2518 referencing billing reference 7004234002. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Date: April 21, 2004

By: 

Antoinette F. Konski
Reg. No. 34,202

Bingham McCutchen, LLP
Three Embarcadero Center, Suite 1800
San Francisco, California 94111-4067
Telephone: (650) 849-4950
Telefax: (650) 849-4800